

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

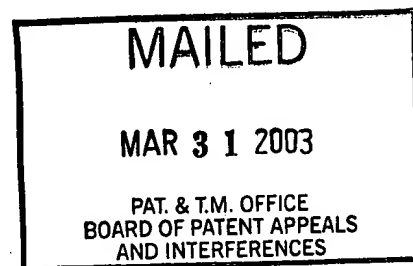
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte ROBERT A. MacDONALD and ROBERT J. RACE

Appeal No. 2002-0757  
Application No. 09/312,352

ON BRIEF



Before COHEN, FRANKFORT, and STAAB, Administrative Patent Judges.  
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 and 3 through 15. These claims constitute all of the claims remaining in the application.

Appellants' invention pertains to a retaining wall block and to a retaining wall. A basic understanding of the invention can be derived from a reading of exemplary claims 1 and 8, respective copies of which appear in the APPENDIX to the brief (Paper No. 18).

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As evidence of obviousness, the examiner has applied the documents listed below:

Dawson	5,913,790	Jun. 22, 1999
Maguire et al (Maguire)	5,951,210	Sep. 14, 1999

The following rejection is before us for review.

Claims 1 and 3 through 15 stand rejected under 35 U.S.C.  
§ 103(a) as being unpatentable over Maguire in view of Dawson.

The full text of the examiner's rejection and response to the argument presented by appellants appears in the final rejection and the answer (Paper Nos. 13 and 19), while the complete statement of appellants' argument can be found in the brief (Paper No. 18).

#### OPINION

In reaching our conclusion on the obviousness issue raised in this appeal, this panel of the board has carefully considered

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appellants' specification and claims, the applied teachings,<sup>1</sup> and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We do not sustain the rejection of claims 1 and 3 through 15 under 35 U.S.C. § 103(a) as being unpatentable over Maguire in view of Dawson for the reasons given below.

At the outset, we focus our attention upon a particular feature in each of appellants' independent claims. Independent claim 1 is drawn to a retaining wall block with a feature being that neck wall members, pin holes, and pin receiving cavities are positioned such that a first plane extending parallel to a plane of symmetry passes through a first pin receiving cavity, a first pin hole and a first neck wall member and a second plane

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<sup>1</sup> In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the Board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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extending parallel to the plane of symmetry passes through a second pin receiving cavity, a second pin hole and a second neck wall member. Independent claim 8 sets forth a retaining wall that has the same noted feature of claim 1.

In rejecting appellants' claims under 35 U.S.C. § 103(a), the examiner articulated the rationale in the final rejection (pages 3 and 4) that it would have been obvious to have substituted the aligning pins and pin cavities of Dawson for the aligning concrete pins and slots of Maguire. In the answer (page 3), the examiner further explains that, while Dawson does not disclose the aligning of pinholes and pin receiving cavities in planes (the noted feature of the independent claims), in making the above modification, one of ordinary skill in the art would place the pins in the same position as the knobs 32 and would place the pin receiving cavities (of Maguire) in a position to receive the pins.

Like the examiner, we fully appreciate the Maguire and Dawson teachings as being highly relevant to the claimed retaining wall block and retaining wall. However, we are not in accord with the stated rationale relied upon for combining the

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reference teachings to yield the now claimed invention. As we see it, the examiner's proposed substitution of the aligning pins (pins and pin holes 44, 36) and pin cavities (pockets 40) of Dawson for the aligning concrete pins (knobs 32) and slot (grooves 30) of Maguire would have effected an arrangement of pins, pin holes, and cavities as depicted in Figs. 1 and 2 of Dawson. The examiner's proposed further modification in changing the position of the cavities (pockets 40) taught by Dawson is readily perceived as an impermissible hindsight modification. Since we have concluded that the rationale before us for rejecting appellants' claims is not sound, the rejection on appeal cannot be sustained.

REMAND TO THE EXAMINER

We remand this application to the examiner to consider the patentability of the claimed subject matter under 35 U.S.C. § 103(a) based upon the combined teachings of Maguire and Dawson and the rationale discussed below.

The patent to Maguire teaches shaped concrete blocks characterized by grooves 30 and rows of knobs 32 (Figs. 1 and 2) such that respective grooves and knobs of successive blocks are engaged when blocks are stacked on top of one another (Fig. 3). It is particularly noted that Maguire teaches round knobs 32 (column 3, line 9) and spaced grooves (outboard of hole 18 in Figs. 2 and 3). The respective round knobs, spaced grooves, and neck members of Maguire's concrete block appear to be such that planes parallel to a plane of symmetry would pass therethrough. The patentee indicates (column 4, line 48 through 50) that knobs and grooves eliminate the need for using pins, which can easily crack and destroy retaining walls.

The patent to Dawson reveals a plantable retaining wall block with at least two pins, at least two pin holes, and at least two pin-receiving pockets (Figs. 1 and 2). However, Dawson acknowledges (column 7, lines 16 through 37) a known alternative to a pin hole connection to be an upwardly extending knob 46 (Figs. 9a, 9b, and 11).

The examiner should determine whether it would have been obvious to one having ordinary skill in the art to replace the

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round knobs of Maguire with pins in holes, in light of the apparent recognition by Maguire and Dawson of pins and knobs as alternatives, taking into account, of course, that Maguire indicates that knobs eliminate the need for using pins.<sup>2</sup>

In summary, this panel of the board has not sustained the rejection of appellants' claims on appeal and has remanded the application to the examiner to consider the matter addressed above.

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<sup>2</sup> The statement by Maguire concerning eliminating the need for pins should be evaluated to determine whether it is a teaching away. In In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994), the court stated that

A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

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The decision of the examiner is reversed.

REVERSED AND REMANDED.

IRWIN CHARLES COHEN  
Administrative Patent Judge

*Charles E. Frankfort*  
CHARLES E. FRANKFORT  
Administrative Patent Judge

BOARD OF PATENT  
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